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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,658	11/23/1999	SATOSHI MUKOGAWA	1075.1123/JD	4075
21171	7590	01/07/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,658

Applicant(s)

MUKOGAWA, SATOSHI

Examiner

Nga B. Nguyen

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 3, 2003 has been entered.
2. Claims 1-41 are pending in this application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vajk et al, U.S. Patent No. 5,256,033 in view of Semple et al, U.S. Patent No. 6,085,177.

Regarding to claims 1 and 18-20, Vajk discloses an automated financial transaction system comprising:

a plurality of automated tellers machines (ATM), each of ATMs performing various transactions responsive to operations by customers, ATMs comprising a first ATM having a message inputs section to input a message for a remittance destination

during a remittance transaction (figure 1 and column 3, lines 50-60, ATM terminals 22, 24, 26, 28; column 9, lines 1-55, ATM having a message inputs section); and

a management apparatus, communicably connected with each of ATMs via an exclusive line, managing the transactions performed by each ATM (figure 1 and column 22, lines 10-40, User's Financial Institution Processor 46 connected with each of ATMs via data communication networks 62 and 16); and

a message depository, communicably connected with first ATM via a communications network, storing the message input by message input section of first ATM (figure 1 and column 16, line 30-column 17, line 5, Store and Forward Message Switch 52 connected with first ATM via a communication network 42 or 64),

said first ATM sending message to message depository via communications network for storage and also sending remittance information and associated depository information to said management apparatus via exclusive line (column 5, line 44-column 6, line 29, the user interacts with the ATM terminal 22, 24, 26 or 28 to send message to the Store and Forward Message Switch 52 for storage; column 25, lines 22-42, the user at one of the terminals 22, 24, 26 or 28 sends a debit or credit card information (equivalent to remittance information), and associated PIN (equivalent to depository information) to the User's Financial Institution Processor 46); and

said management apparatus storing the remittance information and the associated depository information, received from the first ATM, for management purposes (column 25, lines 43-46; column 24, lines 50-65; column 23, lines 36-67, the User's Financial Institution Processor 46 stores user's account records includes debit or credit card information and associated PIN for verification and billing purpose).

Vajk does not disclose communication network is public communications network comprises Internet or Intranet (claims 18-19), that is separate from the

exclusive line, and the associated depository information indicates a site where message is stored in message depository. However, Semple discloses the modified ATM machines in which the user can access to public communication network such as Internet, that is separate from the exclusive line (see column 4, lines 5-58 and figure 1). Semple's system provides the user access to both normal ATM transactions and to the Internet. The user first connects to the bank (via well know exclusive line of the banking network), then the bank connects the user to the public communication network (Internet). Thus the public communication network is separate from the exclusive line of the banking network. Also, in figure 1, the bank 222 connects to the ATM machine and to the Internet via two separate lines. Moreover, it is well known in the art that the associated depository information indicates a site where message is stored. When the user access to the Internet, he/she can access to electronic mail system provided by different Internet servers such as yahoo.com, hotmail.com, etc...to send or receive electronic mail messages. Also, it is well known to indicate a site where message is stored in message depository. For example, when the user establishes an E-mail account with yahoo.com, the user obtains an ID (e.g. micheal@yahoo.com), thus the ID shows that which web site the user having the E-mail account. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Vajk's ATM machines to include Internet access feature for the purpose of providing more convenient for the many users can access to the Internet at ATM machine, not just at home, to perform many Internet transaction such as using electronic mail message.

Regarding to claim 2, Vajk further discloses an information terminal communicably connected with said first ATM via said communications network such

that said first ATM notifies said information terminal of said depository information via communications network (column 6, lines 47-57).

Regarding to claim 3, Vajk further discloses an information terminal communicably connected with said management apparatus via said communications network such that said management apparatus notifies said information terminal of said depository information via said communications network (column 6, lines 58-column 7, line 2).

Regarding to claim 4, Vajk further discloses the notification of said depository information is recognized by a remittance-destination customer at said information terminal, said information terminal is responsive to a request of the remittance-destination customer to read from said message depository said message from a remittance source, based on said notified depository information, and to reproduce said message at said information terminal (column 6, lines 58-column 7, line 2).

Regarding to claim 5, Vajk further discloses the notification of said depository information is recognized by a remittance-destination customer at said information terminal, said information terminal is responsive to a request of the remittance-destination customer to read from said message depository said message from a remittance source, based on said notified depository information, and to reproduce said message at said information terminal (column 6, lines 10-20).

Regarding to claim 6, Vajk further discloses ATMs include a second ATM communicably connected with said message depository via said communications network and having a message reproducing section for reproducing said message from the remittance source which message is stored in said message depository; and wherein when said message from the remittance source is recognized by the remittance-destination customer at second ATM, said second ATM reads from said

message depository information obtained from said management apparatus, and reproduces said message on said message reproducing section.(column 6, lines 10-45).

Regarding to claim 7, Vajk further discloses ATMs including a second ATM, wherein when said message from the remittance source is recognized by the remittance-destination customer at said second ATM, said second ATM obtains from said managements apparatus said depository information of said message from the remittance source and prints said depository information on a passbook of the remittance-destination customer and notifies the remittance-destination customer of said depository information (column 9, line 55-column 10, line 6).

Regarding to claim 8, Vajk further discloses ATMs including a second ATM, wherein when said message from the remittance source is recognized by the remittance-destination customer at said second ATM, said second ATM obtains from said management apparatus said depository information and prints said depository information on a slip addressed to the remittance-destination customer and notifies the remittance-destination customer of said depository information (column 9, line 55-column 10, line 6).

Regarding to claim 9, Vajk further discloses information terminal is communicably connected with said message depository of each said ATM via said communications network and has a message reproducing function for reproducing said message from the remittance source which message is stored in said message depository, said information terminal being operable to read from said message depository said message from the remittance source, based on said notified depository information, and to reproduce the read message at said information terminal (column 13, line 49-column 14, line 20).

Regarding to claim 10, Vajk further discloses information terminal is communicable connected with said message depository of each said ATM via said communications network and has a message reproducing function for reproducing said message from the remittance source which message is stored in said message depository, said information terminal being operable to read from said message depository said message from the remittance source, based on said notified depository information, and to reproduce the read message at said information terminal (column 13, line 49-column 14, line 20).

Regarding to claim 11, Vajk further discloses information terminal is communicable connected with said message depository of each said ATM via said communications network and has a message reproducing function for reproducing said message from the remittance source which message is stored in said message depository, said information terminal being operable to read from said message depository said message from the remittance source, based on said notified depository information, and to reproduce the read message at said information terminal (column 13, line 49-column 14, line 20).

Regarding to claim 12, Vajk further discloses information terminal is communicable connected with said message depository of each said ATM via said communications network and has a message reproducing function for reproducing said message from the remittance source which message is stored in said message depository, said information terminal being operable to read from said message depository said message from the remittance source, based on said notified depository information, and to reproduce the read message at said information terminal (column 13, line 49-column 14, line 20).

Regarding to claim 13, Vajk further discloses information terminal is communicable connected with said management apparatus via said communications network and has a remittance transacting function and a message input function for inputting a message to the remittance destination during the remittance transaction; and wherein, when a message to the remittance destination is inputted by said message input function of said information terminal in response to a customer's operation, said information terminal sends said message to said message depository via said communications network for storage and also sends remittance information and depository information of said message to said management apparatus via said communications network for management by said management apparatus (columns 14-15).

Regarding to claim 14, Vajk further discloses if the remittance transaction mail in said first ATM is for the remittance destination associated with another management apparatus which manages transactions in a unique communicating data format different from the electronic transaction format to be used by the first-named management apparatus, said first ATM sends said remittance information and said depository information of said message to said first named management apparatus via said exclusive line, whereupon said first-named management apparatus sends said remittance information and said depository information to the second-named management apparatus (column 6, lines 10-45).

Regarding to claim 15, Vajk further discloses ATMs include a third ATM which is to be managed by said second-named management apparatus and which is communicable connected with said message depository via said public communications network and which has a message reproducing section for reproducing said message from the remittance source which is stored in said message depository; and wherein

when said message from the remittance source is recognized by the remittance-destination customer at said third ATM, said third ATM reads said message from the remittance source from message depository, based on said depository information obtained from said second-named management apparatus, for reproduction thereby (column 6, lines 10-20).

Regarding to claims 16-17, Vajk further discloses message includes image data and voice data (column 10, lines 24-37 and column 7, lines 3-32).

Claims 21-40 have similar limitations found in claims 1-21 as discussed above, therefore are rejected by the same rationale.

Claim 41 is method claim that is parallel the limitations found in claim 1 as discussed above, therefore, is rejected by the same rationale.

Conclusion

5. Claims **1-41** are rejected.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Souh, can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Art Unit: 3628

c/o Technology Center 3600

Washington, D.C. 20231

or faxed to:

(703) 872-9326, (for formal communications intended for entry)

or:

(703) 308-3961 (for informal or draft communications, please

label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen

Nga Nguyen
December 23, 2003